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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,560	03/29/2004	Nessim N. Isa	1305-01	8295

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EXAMINER

TOWA, RENE T

ART UNIT PAPER NUMBER

3736

DATE MAILED: 04/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/810,560

Applicant(s)

ISA, NESSIM N.

Examiner

Rene Towa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                         |                                                                             |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                                |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____                                                             | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. This Office action is responsive to an amendment filed February 2, 2006. Claims 1 and 4-8 are pending. Claims 2-3 are cancelled. No new claim has been added. Claims 1 and 6 have been amended.

#### ***Specification***

2. The objection is withdrawn due to amendment.

#### ***Claim Objections***

3. The objection is withdrawn due to amendments

#### ***Claim Rejections - 35 USC § 112***

4. The rejection is withdrawn due to amendment.

#### ***Claim Rejections - 35 USC § 102***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
6. Claims 1 and 4-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Crandell et al. (US Patent No. 3,277,714).

Crandell et al. disclose a receiver comprising:

an elongate handle 20 having a longitudinal axis;

collection means 10 capable of collecting and retaining endocervical curettings, attached to said handle 20, at a proximate end of said collection means 10, and wherein said collection means 10 has a circumferential edge which is smooth and capable of avoiding cutting or scrapping of the cervical area (see fig. 1);

wherein said collection means 10 has a concave, spoon shape;

wherein said collection means 10 has a truncated end at a distal end of said collection means 10;

wherein said receiver is fabricated from stainless steel; wherein said receiver is fabricated from a plastic material that can be discarded after use (see column 4/lines 55-60).

7. Claims 6-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Kresch et al. (US Patent No. 5,527,331).

Kresch et al. disclose a method for obtaining tissue from inside a living body, the method comprising the steps of:

inserting a curette P having sharp cutting edges 21 inside a body,

inserting the collection means 16 of an endocervical curettings receiver inside the body, and positioning said receiver 16 adjacent to said curette P, wherein said receiver 18 comprises an elongate handle having a longitudinal axis; collection means for retaining said endocervical curettings, attached to said handle, at a proximate end of said collection means, wherein said collection means preferably has a concave, spoon shape, and has a truncated end at a distal end of said collection means; and said collection means has a circumferential edge which is smooth to avoid cutting or scrapping of the cervical area;

moving said inserted curette P to cause one or more cutting edges 21 on said curette to cut tissue from the body;

placing or collecting said cut tissue within the collection means 16; and

withdrawing said curette P and said collection means 16 from the body (see figs. 3A-B, 4-5; column 4/lines 33-47);

wherein said collector 18 of said endocervical curettings receiver 16 is at least twice the size (in volume), of a collector section 25 formed as part of the curette P;

wherein said collector 18 is between 5 and 20 times the size (in volume), of a collector section 25 formed as part of the curette (see fig. 2A).

### ***Response to Arguments***

8. Applicant's arguments filed February 2, 2006 have been fully considered but they are not persuasive. Applicant contends that Crandell teaches a spoon that may not be used as a curetting receiver. Applicant further contends that Kresch does not need a curetting receiver in its method. These arguments have been considered and have not been deemed persuasive.

In regards to the Applicant's argument that Crandell teaches a spoon that may not be used as a curetting receiver, the Examiner respectfully traverses. The Applicant is reminded that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. As such, the receiver of Crandell is structural equivalent to the Applicant's claimed invention and is capable of receiving endocervical curettings. Moreover, spoons are well-known household items that come in different shapes and sizes. It has previously been held that changing size

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is a design choice that is not patentable --See see *In re Rose*, 220 F.2d 459, 463, 105 USPQ 237, 240 (CCPA 1955).

In regards to the Applicant's argument that Kresch does not need a curetting receiver in its method, the Examiner respectfully disagrees. Whether or not Kresch needs a curetting receiver does not appear to be the issue. Kresch discloses a method comprising using a curetting receiver 16 to collect the cells and a curette comprising cutting tips 101 to cut the cells (see figs. 5 & 6A). Moreover, the types and/or states of the cells that collected in Kresch's method is immaterial since the method claim fails to set forth, inter alia, at least one of the location of the body cavity in which the method is carried out and the state of the collected.

In view of the foregoing, the rejections over at least one of Crandell and Kresch are maintained.

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rene Towa whose telephone number is (571) 272-8758. The examiner can normally be reached on M-F, 8:00-16:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RTT

  
**MAX F. HINDENBURG**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 3700**